

Office Action Summary

Application No.

10/821,924

Applicant(s)

YUEN, YAT KEUNG WILLIAM

Examiner

QUYNH-NHU H. VU

Art Unit

3763

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-40, 42-55 and 57-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-40, 42-55, 57-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 4/1/09
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Amendment filed on 3/20/09 has been entered.

Claims 1-15, 17-40, 42-55, 57-59 are present for examination.

Claims 16, 41 are cancelled.

Applicant's arguments and Amendment, filed 3/20/09, with respect to the rejection(s) of claim(s) 1-15, 17-40, 42-55, 57-59 have been fully considered and are persuasive.

Claims 16-18 and 56-59 were previously indicated as allowable. However, there is 112th issue. Therefore, the last Final rejection has been withdrawn. However, upon further consideration, since the new rejection is necessitated by amendment, the present Office Action is made Final. a new ground(s) of rejection is made in view of new Final Office.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 17-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The limitation "a chamber adapted to be in fluid communication with said hood member via a first valve" of claim 1 is mis-descriptive. According to Specification on page 5, lines 11-14, it states that: the first one-way valve 70 only allow air to enter the chamber 71 from a conduit 72, which is in turn in fluid communication with the hood 12. In other words, the conduit 72 is in fluid communication with the hood 12, but the chamber 71 is not adapted to be in fluid communication with the hood member 12. The chamber 71 is adapted or allows the air to enter into the chamber 71.

Applicant states in claim 4 that the first valve is one-way valve. Therefore, Examiner assumes that the first valve denotes for element 70. As note that, the one-way valve 70 only allows air to enter the chamber 71 from the conduit 72 (pg 5, lines 11-13).

The limitation that: "a second valve in fluid communication with the hood member" of claim 1 and the limitation: "a second motor for selectively opening or closing said second valve" of claim 17; the limitation "during operation of said breast pump, said second valve is openable to release the vacuum in said hood member" of claim 18 are not consistency. For example: a second valve can be denoted for element 96 in fluid communication with the hood member 12. However, Applicant further states that: the second motor denoted for element valve motor 46 only selectively opening or closing the needle valve 48, as in claim 17. As known that, the needle valve 48 is connected via a hose (not shown), with a nozzle 50 which is in turn pneumatically connected with the mil-k receiving bottle 18 (page 4, lines 7-9 of Specification). In other words, if Applicant defines a second valve is as needle valve 46, the second valve/needle valve 48 is connected via a hose through a nozzle 50 and connected with the milk-receiving bottle 18 but not in fluid communication with the hood member 12, as in claim 1.

Does Applicant mean that the second valve as a needle valve 48 or a one-way valve 96 in fluid communication with milk bottle?

Examiner requests that Applicant should clearly point out the denote numbers of 1st valve, 2nd valve, 3rd valve, 4th valve. Beside that Applicant should clearly state the relationship between the valves in either air or fluid communication with other members in the breast pump device.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-4, 10-14, 18, 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Schlenzog et al. (US 4,673,388).

As best as understood, Schlenzog discloses an electric breast pump including:

Examiner interprets first assuming:

hood member 101; a chamber 180; a first valve 245;

Examiner interprets second assuming:

a hood member 101, a chamber 223 adapted to be in fluid communication with the hood member 101 via a first valve 29 or 294

Schlenzog further discloses the breast pump comprising:

a first motor 21 operatively associated with a pumping member;

wherein the chamber having a first opening 286 and a closure member 181 or 280 operatively associated with the first motor 21

when the motor ON (at first position), the cover portion 181 can be pressed downwards, the projection 280 presses the valve 281 downwards against a spring 289 and thereby connects the chamber 207 with the atmosphere through the opening 286. In other words, the closure member (includes 181 and 280) is cooperated with the valve 281 to close the opening 286.

When the motor OFF (at the second position), or the cover portion 181 is released, the spring 289, 230 and the projection 280 upwards, at this point the opening 286 opened (Fig. 2, col. 6, line 4+).

A second valve 254 in air communication with chamber 180; an adjustment member 282; a third valve 281

It has been held that the recitation that a chamber is "adapted to be in fluid communication with said hood member via a first valve" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Additionally, it is well established that a recitation with respect to the manner in which an apparatus is intended to be employed, i.e., "...operatively associated with a pumping member which is movable to draw air from said hood member into said chamber via said first valve" of claim 1, a limitation

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"allows air to exit said chamber" of claim 12, functional limitations, do not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim, see *In re Pearson*, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974).

Claims 30-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Greter et al. (US 6,547,756).

Greter discloses an electric breast pump including: a hood member 16, a chamber; infrared (IR) unit (col. 2, lines 24+); wherein the infrared unit includes microprocessor 60 for transmitter and receiver data (col. 5, lines 24+, col. 6, line 65-col. 9, line 55); a LDC display 48; a motor

It has been held that the recitation that a pumping member, a first motor is "adapted" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Additionally, it is well established that a recitation with respect to the manner in which an apparatus is intended to be employed, i.e., "...for transmitting IR signal and for receiving ...IR transmitter" of claim 30, the limitation "a time for determining the time ...IR unit" of claim 35; the limitation "...prevented from being received by said IR receiver upon passing of milk therebetween" of claim 36, functional limitations, do not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim, see *In re Pearson*, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlensog et al.

Schlensog discloses the invention substantially as claimed. Schlensog further disclose the first motor is engaged with the closure member via the movement of cam 212 and piston 21.

Schlensog does not specifically show the cam includes a ring-shaped structure. However, it is well-known in the motor art to provide a motor includes the cam with a ring-shaped structure for movement between the cam and piston from one position to another position.

Claims 15, 19-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlensog et al. in view of Greter et al. (US 6,547,756).

Schlensog discloses the invention substantially as claimed. Schlensog fails to disclose a wheel member; the chamber includes a sensing unit, data processing unit, and a display.

Greter discloses that the adjustment member manually includes a wheel member (rotary knob) (col. 4, line 5-14); a sensing unit (infrared data transfer or received the data or sensing mechanism), data processing unit, a LCD display 48, see (col. 2, lines 25+, col. 7, line 1-col. 9, line 55).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the device of Schlensog with a manually adjustment member, a sensing, data processing unit and a LCD display, as taught by Greter, for adjusting the suction level as well as rate within a sequence and in order to gain the commonly understood benefits of such adaptation, such as for visually indicating the flow rate of milk into the breast pump.

The display provides visual indications of various function of the pump, for example, the type of sequence then programmed, the level of suction force, the battery condition, and so forth. The sensing unit or data processing unit such as microprocessor is capable of downloading or transfer to the chip card.

Furthermore, it would have been obvious to one of ordinary skill in the breast pump art to provide an adjustment member manually in device of Greter, in order to gain the commonly understood such as the device capable to operative without an electric power source, enabling it to be readily transported and used anywhere.

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It has been held that the recitation that a sensing unit, a data processing unit, pumping member, a first motor is "adapted to" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Additionally, it is well established that a recitation with respect to the manner in which an apparatus is intended to be employed, i.e., "...determining the time duration between when passing of milk is detected by the first sensing unit and when passing of milk is detected by said second sensing unit" of claim 24, functional limitation, does not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim, see In re Pearson, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974)

Claims 41-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greter et al. in view of Schlensoeg et al.

Since claims 41-56 are similar to claims 1-15. Please see the rejections above.

Allowable Subject Matter

Claims 17, 57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 59 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to QUYNH-NHU H. VU whose telephone number is (571)272-3228. The examiner can normally be reached on 6:00 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas D Lucchesi/
Supervisory Patent Examiner, Art Unit 3763

Quynh-Nhu H. Vu
Examiner
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